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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,845	11/13/2003	Hisayuki Takasu	N9460.0018/P018	4874
24998	7590	09/10/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L STREET NW WASHINGTON, DC 20037-1526			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,845

Applicant(s)

TAKASU ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

This application is up for consideration.

- A. In view of the complexity of the issues in the claims as set up, this Office action is made.
- B. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 4-5,7 and 9, drawn to an apparatus, classified in class 396, subclass 564+. If applicants elect this invention, the application will be transferred to be examined by a qualified examiner in Technology Center 2851.
 - II. Claims 1, 4-5,7 and 9, drawn to another patentably different and distinct apparatus as divided by applicants from that in Group I above, classified in class 396, subclass 564+. If applicants elect this invention, the application will be transferred to be examined by a qualified examiner in Technology Center 2851.
 - III. Claims 10 and 14, drawn to a processing steps, classified in class 430, at least subclass 294.
 - IV. Claims 11 and 14, drawn to another patentably different and distinct processing steps as divided by applicants from that in Group III above, classified in class 430, at least subclass 323.
 - V. Claims 12 and 14, drawn to another patentably different and distinct processing steps as divided by applicants from any one of those in Group III and Group IV above, classified in class 430, at least subclass 325.

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- VI. Claims 13 and 14, drawn to another patentably different and distinct processing steps as divided by applicants from any one of those in Group III, Group IV and Group V above, classified in class 430, at least subclass 299.
- VII. Claim 15, drawn to another patentably different and distinct apparatus as divided by applicants from any one of those in Group I and Group II above, classified in class 396, subclass 564+. If applicants elect this invention, the application will be transferred to be examined by a qualified examiner in Technology Center 2851.
- VIII. Claim 16, drawn to another patentably different and distinct processing steps as divided by applicants from any one of those in Group III, Group IV, Group V and group VI above, classified in class 430, at least subclass 327.

The inventions of Groups I, II and VII are all related to the materials but have the patentably different and distinct materials that make up the apparatus and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination as indicated is proper. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

The inventions of Groups III, IV, V, VI and VIII are all related to the processes but have the patentably different and distinct processing steps and have acquired and have the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination as indicated is proper. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction

would not be removed.

Inventions Groups I, II and VII and Groups III, IV, V, VI and VIII are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, at least the process of a development using a solvent to wash out a soft portion of an exposed polymer layer on a substrate can be done in a washing tank instead of chamber as claimed or at least a pressurized chamber can be used to disinfect a bio-matter other than to etch a substrate in the claims. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

C. An additional consideration or search for more than one invention or subclass in the art is burdensome. Applicant should show or provide a convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

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D. Applicant is advised that the reply to this requirement to be complete must include full elections and requirements to be examined even though the requirement be traversed (37 CFR 1.143).

E. Other issues have not been considered until full and proper elections and requirements are made and resolved.

F. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
07 September 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le